REMARKS

Claims 1-10 are pending in this application. Claims 1, 2, and 5-10 stand rejected and claims 3 and 4 are objected to. In light of the remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1, 2, and 5-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,262,637 ("Bradley") in view of U.S. Patent No. 6,356,746 ("Katayama"). Applicant respectfully requests reconsideration and withdrawal of this rejection.

In the "Response to Arguments" section of the Office Action, the Examiner disagrees with Applicant's statement that column 1, lines 18-19 in Bradley does not disclose attenuation since the duplexer provides isolation between ports and thus is not attenuating. The Examiner states that "this is not persuasive since the ultimate form of attenuation is isolation – in other words, isolation occurs when there is lots of attenuation." See Office Action at page 2. Taken to the ultimate conclusion, this would mean that a switch would be viewed as an attenuator. Clearly, this is not what the Examiner intended.

Further, one skilled in the art would not equate the isolating function of a duplexer with an attenuator. In the disclosed duplexer, isolation is provided between ports 24 and 26, whereas the filter (attenuation) is provided between ports 24 and 28 or 26 and 28. Thus, Applicant reasserts that Bradley fails to disclose a second attenuation amount as recited in the claims.

Paragraph 3 of the Office Action addresses the control means for setting attenuation amounts in the filters. The Examiner asserts that the filters are configured therefore they are controlled. This makes no logical sense. The phrase that the filters "are configured" relates to designing the filters, not to a means of controlling the filters whereby the filter response can be changed during operation. As such, contrary to the position taken by the Examiner, design choice, i.e., configuration, is not the equivalent of control means.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

The Office Action asserts that Bradley discloses an adjustable filter means for reducing leakage power outside a transmission signal band, said filter means having a first attenuation amount more than a predetermined amount or a second attenuation amount not more than the predetermined amount selectively set in a range higher than a transmission signal band. This feature is not present in Bradley.

In Bradley, as shown in Figure 2, there are two distinct pass bands. A first pass band represented by the dashed line 36, i.e., the response of film 30 in the path from port 24 to 28 and a second pass band represented by solid line 38, i.e., the response of filter 32 in the path from port 28 to 26. Additionally, there is isolation between ports 24 and 26. See col. 1, lns. 18-19. Thus, there is no adjustable filter having first and second attenuation amounts as recited in Applicant's claims.

In Applicant's claim, the first and second attenuation amounts of said adjustable filter are the adjustable filter means for reducing leakage power outside a transmission signal band. As such, the adjustable filter is used for a band outside the transmission signal band.

The disclosed filters 30 and 32 in Bradley are for separate and distinct pass bands, i.e., the transmit band and the receive band. This is not the adjustable filter having first and second attenuation means disclosed by Applicant. The filter having first and second attenuations recited in Applicant's claims is between a first and second port.

In contrast, according to the Examiner's rejection, the first attenuation amount is shown in Figure 2 as reference numeral 36, the attenuation response in filter response between ports 24 and 28. The second attenuation amount is disclosed in Bradley at column 1, lines 18-19, which is the isolation between ports 24 and 26. That would mean that the first attenuation amount is provided by band-pass filter 30 between input port 24 and output port 28 and the second attenuation amount, which is the duplexer which provides isolation between the transmitter and

receiver is measured between input port 24 and output port 26. Thus, clearly this is not the attenuation disclosed and claimed by Applicant. As such, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Further, Applicant explicitly recites control means for setting one of the first and second attenuation amounts in said adjustable filter means in accordance with a use situation of a band adjacent to the transmission signal band. This feature is not present in Bradley.

The Office Action asserts that this feature is disclosed in Bradley at column 1, lines 55-60 where it states "in the example shown, band-pass filters are configured such that the high frequency stop band of the band pass filter 30 overlaps with the pass-band of the band-pass filter 32 and the low-frequency stop band of the band-pass filter 32 overlaps the pass-band of the band-pass filter 30." See Office Action at 3. However, this is not the control means explicitly recited by Applicant. This is merely a design choice as discussed above.

The Office Action asserts that it would have been obvious to combine Bradley and Katayama because the combined teaching of Bradley and Katayama suggests an adjustable filter as recited in the instant claims. This is incorrect because one would not be motivated to combine these two references.

As a motivation to combine, the Examiner states that Bradley suggests configuring a filter (something broad) in general and Katayama suggests the beneficial use of adjusting or configuring the filter periodically. However, Bradley

states that the filters are configured such that the high frequency stop band of the band-pass filter overlaps the pass-band of the band-pass filter and the low frequency stop band of the band-pass filter overlaps the pass-band of the band-pass filter. In other words, the filters are designed in a specific manner. This does not suggest a variable design as asserted by the Examiner. As such, there is no motivation in the references to combine Katayama with Bradley and a *prima facie* case of obviousness has not been made with respect to providing a motivation to combine these references which, as discussed above, do not disclose the claimed invention.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: March 8, 2005

Respectfully submitted,

By_____

Ian R. Blum
Registration No.: 42,336
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 Avenue of the Americas
New York, New York 10036-2714
(212) 835-1400
Attorney for Applicant

IRB/mgs